

REMARKS:

Claims 1-16, 19, 20, 23, 24, 27-33 and 35-49 are pending in the present application. Claims 3, 4, 7, 8, 11, 12, 15, 16, 19, 20, 23, 24, 27-33, 35-38, 41, 42, 45, 46, 48, and 49 have been withdrawn. By his Office Action dated November 24, 2003, claim 44 was allowed, claim 47 was objected to, and all remaining claims were rejected.

As a preliminary matter, applicants note the Examiner's observation that applicants' Amendment of September 8, 2003, contained incorrect claims status notations. Specifically, a number of the amended claims reflected "(Previously amended)" when they should have indicated "(Currently amended)." By the present amendment, these errors have been corrected.

Claims 2, 5, 6, 9, 10, 13, 14, 39, 40 and 43 were rejected by the Examiner under 35 USC § 112, second paragraph. Specifically, the Examiner requested that the definition for the term "Aryl" be inserted in the claims utilizing that term. By the present amendment, this definition has been inserted in the indicated claims. Applicants note that the definition already existed in claim 43. The Examiner also requested the correction of a typographical error in claim 14 – the misspelling of the term "consisting". That correction has been effected by the present amendments as well.

Claims 1 and 43 were rejected under 35 USC § 112, first paragraph, for failure to comply with the written description requirement relating to applicants' amendment adding a proviso concerning R² and R¹. Applicants respectfully traverse. The Examiner cites the MPEP at § 2173.05(i) and *Ex parte Grasselli* for the proposition that negative limitations or exclusionary provisos "must have basis in the original disclosure." However, omitted from the Examiner's quotation from the MPEP are passages that add significant clarification regarding what constitutes a "basis in the original disclosure." "The specification, having described the whole necessarily describes the part remaining." MPEP § 2173.05(i) citing *In re Johnson*, 558 F.2d 1008, 1019, 194 USP 187, 196 (CCPA 1997). The MPEP also states, "Note that a lack of literal basis in the specification for a

negative limitation may not be sufficient to establish a *prima facie* case for lack of descriptive support." *Id.* The *Ex parte Grasselli* case cited by the Examiner is easily distinguished on the facts. There, the claim at issue was a process claim involving a catalyzed reaction. The negative limitation that applicants had added by amendment required that the catalyst be "free of uranium and the combination of vanadium and phosphorus." This limitation then did not amount to a carving out from the scope of the invention, but rather a modification of the catalyst material that was the heart of the invention.

By way of contrast, the present case involves a conventional *proviso* to remove overlap with or to provide further distance from the prior art. The essence of the invention is not altered, and *Ex parte Grasselli* is not applicable. Rather, the *proviso* currently in issue should be evaluated under the standard articulated by *In re Wertheim*:

[W]e must decide whether the invention appellants seek to protect by their claims is part of the invention that appellants have described as *theirs* in the specification. That what appellants claim as patentable to them is *less* than what they describe as their invention is not conclusive if their specification also reasonably describes that which they do claim. Inventions are constantly made which turn out not to be patentable, and applicants frequently discover during the course of prosecution that only a part of what they invented and originally claimed is patentable. As we said in a different context in *In re Saunders*, 58 CCPA 1316, 1327, 444 F.2d 599, 607, 170 USPQ 213, 220 (1971):

To rule otherwise would let form triumph over substance, substantially eliminating the right of an applicant to retreat to an otherwise patentable species merely because he erroneously thought he was first with the genus when he filed. Cf. *In re Ruff*, 45 CCPA 1037, 1049, 256 F.2d 590, 597, 118 USPQ 340, 347 (1958).

In re Wertheim, 191 USPQ 90, 96 (CCPA 1976) (emphasis in original). The present specification clearly provides support for the broader claim (i.e. without the proviso), and therefore also provides adequate § 112 support for the claim with the proviso restricting R¹ and R² when the heteroaryl is thiophene.

For the foregoing reasons, applicants respectfully submit that the claims as amended do not run afoul of §112, whether first or second paragraph.

Claim 43 was rejected under 35 USC § 102(b) as being anticipated by Mizuno et al. Applicants respectfully traverse. As noted in applicants' previous amendment, the "Aryl" component of the compounds described in claim 43 must be a heteroaromatic ring. No heteroaromatic rings, however, are disclosed in the compounds referenced by the Examiner (compound numbers 28-79 of Table 1 in Mizuno et al.). Applicants respectfully submit, therefore that claim 43 is not anticipated by Mizuno et al. and again request the Examiner's favorable reconsideration.

Claim 44 was allowed.

Claim 47 was objected to as being dependent upon a rejected base claim. In view of the present amendments to claim 1 (from which claim 47 depends) to overcome the Examiner's § 112 rejection, applicants submit that claim 1 is now in allowable form and that it is unnecessary to put claim 47 into independent form. Consequently, claim 47 was not amended.

For all the foregoing reasons, applicants respectfully submit that all claims are now in condition for allowance, and the Examiner's favorable consideration is requested. In the event there are any questions concerning the present amendments or discussions above, the Examiner is encouraged to call the undersigned at 817/551-4322.

4/26/04
Date

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